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To: EXAMINER MOREHEAD

Location: USPTO

Facsimile Telephone: 703-305-7401

No. of Pages: (including this page)

10

From: Bryan C. Zielinski - Patents/New York

Department Name: Legal Division

Charge No.: 88421

Facsimile Telephone: (212) 573-1939

Date: 2/12/99

Time (New York)

11 AM

TO CONFIRM RECEIPT OF TRANSMISSION, CALL 212 573-4585

Re: PFIZER 09/007,268


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---------------|-------------|----------------------|---------------------|
| 08/167,881 | 12/14/93 | LOWE | J PC7981AKXD |

 PETER C. RICHARDSON
PFIZER INC.
235 EAST 42ND STREET
NEW YORK, NY 10017-5755

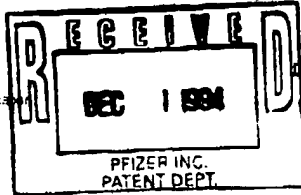
12M2/1128 ✓

EXAMINER
SCALZOG

ART UNIT PAPER NUMBER

1206

DATE MAILED: 11/28/94

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 30 month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION
PLEASE SEND TO:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Claims <u>1-41, 44, + 52</u> | FOR _____ AJS _____ are pending in the application. |
| Of the above, claims _____ | LCA _____ PHG _____ |
| | MLP _____ JTL _____ are withdrawn from consideration. |
| 2. <input checked="" type="checkbox"/> Claims <u>42, 43, + 45-51</u> | BGB _____ JLI _____ have been cancelled. |
| | GXB _____ RES _____ |
| 3. <input type="checkbox"/> Claims _____ | BTC _____ EDS _____ |
| | BMC _____ GGB _____ are allowed. |
| 4. <input type="checkbox"/> Claims _____ | VXD _____ MEG _____ are rejected. |
| | NXD _____ JCC _____ |
| 5. <input type="checkbox"/> Claims _____ | RCF _____ DSM _____ are objected to. |
| | VNF _____ JSM _____ |
| 6. <input checked="" type="checkbox"/> Claims <u>1-41, 44 + 52</u> | GFF _____ ADO _____ are subject to restriction or election requirement. |
| | GXA _____ RWA _____ |
| 7. <input type="checkbox"/> This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes. | HTV _____ TCN _____ |
| | CNU _____ ALP _____ |
| 8. <input type="checkbox"/> Formal drawings are required in response to this Office action. | |
| 9. <input type="checkbox"/> The corrected or substitute drawings have been received on _____ Under 37 C.F.R. 1.84 these drawings are <input type="checkbox"/> acceptable. <input type="checkbox"/> not acceptable (see explanation or Notice re Patent Drawing, PTO-848). | |
| 10. <input type="checkbox"/> The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been <input type="checkbox"/> approved by the examiner. <input type="checkbox"/> disapproved by the examiner (see explanation). | |
| 11. <input type="checkbox"/> The proposed drawing correction, filed on _____ has been <input type="checkbox"/> approved. <input type="checkbox"/> disapproved (see explanation). | |
| 12. <input type="checkbox"/> Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has <input type="checkbox"/> been received <input type="checkbox"/> not been received <input type="checkbox"/> been filed in parent application, serial no. _____ : filed on _____ | |
| 13. <input type="checkbox"/> Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213. | |
| 14. <input type="checkbox"/> Other _____ | |

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EXAMINER'S ACTION

Serial Number: 08/167881
Art Unit: 1206

-2-

1. This application contains claims 1-41, 44 and 52 directed to various patentably distinct species of the claimed invention.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

2. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Scalzo whose telephone number is (703) 308-4696.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

/csks-2

11-25-94

Catherine Scalzo
CATHERINE S. KILBY SCALZO
EXAMINER
ART UNIT 1206


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

SERIAL NUMBER FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.

08/167,881 12/14/93 LOWE

J PC798145X0

SEALZG, C EXAMINER

12M2/0307

 PETER C. RICHARDSON
 PFIZER INC.
 235 EAST 42ND STREET
 NEW YORK, NY 10017-5755

ART UNIT PAPER NUMBER

1206

6

DATE MAILED

03/07/95

 This is a communication from the examiner in charge of your application.
 Please read it carefully and respond to it as soon as possible.

MAR 13 1995

- ☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Art Cited by Applicant, PTO-1449.
3. ☐ Information on How to Effect Drawing Changes, PTO-1474.
4. ☐ Notice re Patent Drawing, PTO-948.
5. ☐ Notice of Informal Patent Application, Form PTO-152.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-41, 44, + 52-54 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 42, 43, 45-51 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-41, 44, + 52-54 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable, ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved, ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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INFORMATION DISCLOSURE CITATION

(Use several sheets if necessary)

Page 1 of 1

ATTN. DOCKET NO.
PC7952B

SERIAL NO.
NOT YET ASSIGNED

APPLICANT
JOHN A. LOWE, III and TERRY J. ROSEN

FLING DATE
HEREWITH

GROUP 1206

U.S. PATENT DOCUMENTS

[illegible]

FOREIGN PATENT DOCUMENTS

| FOREIGN PATENT DOCUMENTS | | | | | | | | | | | | | | | |
|--------------------------|-----|-----------------|----|---|---|---|---|---|-------------|----------|-------------------|----------|-------------|----|--|
| | | DOCUMENT NUMBER | | | | | | | PUB DATE | COUNTRY | CLASS | SUBCLASS | TRANSLATION | | |
| | | | | | | | | | | | | | YES | NO | |
| ✓ 122 | (a) | WO | 90 | / | 0 | 5 | 7 | 2 | 9 | 5/31/90 | PCT Patent Appln. | | | | |
| | (b) | WO | 91 | / | 0 | 9 | 8 | 4 | 4 | 7/11/91 | PCT Patent Appln. | | | | |
| | (c) | WO | 91 | / | 1 | 8 | 8 | 8 | 9 | 12/12/91 | PCT Patent Appln. | | | | |
| | (d) | WO | 92 | / | 0 | 1 | 6 | 8 | 8 | 2/6/92 | PCT Patent Appln. | | | | |
| ✓ | (e) | WO | 92 | / | 0 | 6 | 0 | 7 | 8 | 4/18/92 | PCT Patent Appln. | | | | |

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)

| REFERENCES (including Author, Title, Date, Pertinent Pages, Etc.) | | | |
|---|--|--|--|
| | | | |
| | | | |
| | | | |

EXAMINER

CSK Signal z_0

DATE CONSIDERED

3/1/95

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Conforms with FORM PTO-FB-A820

INFORMATION DISCLOSURE

1203792.KXP (a/m)

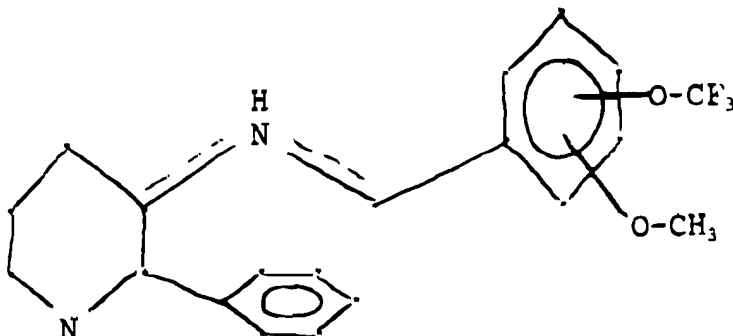
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Serial Number: 08/167881

-2-

Art Unit: 1206

1. Applicants have responded to the election of species requirement by selecting the compound of the formula:



This compound is the same as the one elected in the parent case.

A number of other compounds have also been examined in addition to the above species; the examined matter is as follows and forms Group I, below.

Restriction under 35 USC 121 is required to one of the following inventions:

Group I: Compounds, compositions, and methods where the compound's "Q" moiety is of Formula VII, and "X" is $-(CH_2)_3-$, and none of the substituents can contain a nitrogen-containing six or seven membered ring (e.g. pyridyl, quinoline, piperidine), and R₆ and R₇ may not join.

Claims 1, 7, 11-25, 27, 28, 31-41, 52-54 contain these types of compounds.

Group II(+): Other subject matter.

These Groups of inventions are separate and distinct due to their individual and widely divergent structures. A reference teaching only the compounds of Group I would not be anticipatory of the Group II compounds, nor would the Group II compounds be obvious from it, in the absence of a reference teaching otherwise.

Applicant is required to make a statement of which Group is elected, as a matter of form. The elected species is a part of Group I, so normally Group I would be the elected Group also.

Serial Number: 08/167881

-3-

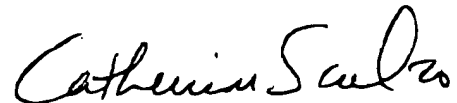
Art Unit: 1206

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Scalzo whose telephone number is (703) 308-4696.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

/csks-5

3-6-95



CATHERINE S. KILBY SCALZO
EXAMINER
ART UNIT 1206


UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|---------------|-------------|----------------------|---------------------|
|---------------|-------------|----------------------|---------------------|

08/167,881 12/14/93 LOWE

J PC7981AKXD

SCAL 70.0 EXAMINER

12M2/0807

 PETER C. RICHARDSON
 PFIZER INC.
 235 EAST 42ND STREET
 NEW YORK, NY 10017-5755

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1208

9

AUG 14 1995

DATE MAILED: 08/07/95

 This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5/22/95 ☐ This action is made final.

 A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 7, 9-25, 27, 28, 31-41, 52-56 are pending in the application.
 Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-6, 8, 26, 29, 30, 42-51 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 7, 9-25, 27, 28, 31-41, 52-56 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EXAMINER'S ACTION

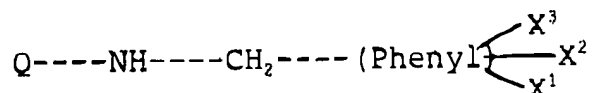
Serial Number: 08/167881
Art Unit: 1208

-2-

1. In the response from Applicant dated May 22, 1995, the species found at the bottom of page 6 of the election paper was elected with traverse, however it is noted that this structural portrayal of the compound elected is incorrect; it apparently should have a NH linker in place of the bent line denoting a CH₂ linker attached on the piperidine ring. (A telephone conversation was initiated by the Examiner on August 4, 1995 with applicants' council, Ms. DeBenedictis to mention it).

Also, applicants have stated that this case is filed under 35 USC 371, so the PCT unity requirements are to be followed rather than the 35 USC 121 restriction practice. That observation is correct; therefore, the restriction requirement is hereby converted into a PCT lack of unity statement, as follows.

Lack of unity has been found in this application under the PCT guidelines. Several groups of inventions have been found to exist in this application which are too numerous to list. However, applicants have indicated their preferred species to be:



where Q is 2-phenyl-3-yl-piperidinyl,
one of the X groups is OCH₃, another is OCF₃, and
the last one is H.

Therefore, Group I is as follows:

(I) Compounds, compositions and uses where
Q is piperidinyl, and there are no other
heterocycles in the compound.

(II+) Other compounds.

In situations similar to this one, where there are so many different ring core structures, an applicant is often concerned that the costs incurred from the filing of numerous divisional applications would be prohibitive, and thus many inventions would be lost. The US PTO is also concerned with this, since it is our intention that inventions be released into the public domain, and thereby further the state of the art. Accordingly, examination will begin with the Group I invention listed above, but if it is seen that the scope of the examination can be extended, it will be. It is possible that some substituents which are heterocyclic might be included in the future or even some of the Q ring systems other than the piperidinyl, if allowable subject matter is found. For now, however, it is best if the claims remain essentially as they are (except perhaps with a change to the R²

Serial Number: 08/167881
Art Unit: 1208

-3-

and R² definitions as discussed below). (And perhaps an inclusion of "fluoroalkoxybenzylamino" just before "compound" in the preamble, since the presence of the fluoroalkoxy group is required and is a significant element to the invention herein).

2. Claims 7, 9-25, 27, 28, 31-41 and 52-56 are rejected under 35 U.S.C. § 112, second paragraph, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definitions for R⁸ and R⁹ do not include the possibility of a spiro group being formed, but the spiro is mentioned in the proviso language (page 5 of the most recent amendment, line 12).

3. Any inquiry concerning this communication or earlier communications should be directed to **Examiner Scalzo** [(703) 308-4696, 7:30-6:00 Tuesday-Friday (or SPE Geist at (703) 308-1701)]. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

/csks-6
8-4-95

Catherine Scalzo

Catherine Kilby Scalzo
Examiner
Art Unit 1208